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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: ERNEST W. MOODY

Appl. No.: 09/894,501

Art Unit: 3714

Filed: June 28, 2001

Examiner: Coburn, C.

For: APPARENT SKILL GAME USED AS A BONUS ROUND
ON A GAMING MACHINE

MAIL STOP APPEAL BRIEF -- PATENTS
Commissioner for Patents
P.O. BOX 1450
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APPELLANTS' APPEAL BRIEF

1. REAL PARTY IN INTEREST

This application has not yet been assigned, but it is under contract to be assigned to Action Gaming, Inc., a Nevada corporation.

I hereby certify that this correspondence is being deposited with the United States Postal Service as on this date November 3, 2003 in an envelope as "Express Mail Post Office to Addressee" Mailing Label No. ER155256140US addressed to: MAIL STOP APPEAL BRIEF -- PATENTS, COMMISSIONER FOR PATENTS, PO BOX 1450, ALEXANDRIA, VA 22313-1450.

Ernest W. Moody
Applicant(s)

Signature

November 3, 2003

Date of Signature

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

3. STATUS OF CLAIMS

Claim 1 is pending in this application. Claim 1 stands rejected.

4. STATUS OF AMENDMENTS

There are no Amendments after Final Rejection.

5. SUMMARY OF THE INVENTION

The present invention includes an apparent game of skill or knowledge as a secondary event bonus round game which is won by the player during the play of a conventional electronic or mechanical gaming machine. A gaming machine, such as a slot machine, poker game machine, keno game machine, bingo game machine or other casino game of chance machine is first played by the player and, upon the occurrence of a predetermined outcome of the gaming machine, the player wins an opportunity to play the secondary event bonus round game.

At the commencement of the secondary event bonus round game, the computer controls of the electronic gaming machine first

select the amount of the award to be won by the player during the play of the secondary event game. The player then plays out the secondary event bonus round game, which appears to the player to be a game of skill or knowledge. Regardless of how the player fares during the play of the secondary event bonus round game, the play of the secondary event bonus round game continues until the player has achieved the predetermined amount that was selected by the computer controls. Thus, the player's skill or knowledge level or ability during the play of the secondary event bonus round game has no affect on the amount won by the player during the play of the secondary event bonus round game.

Claim 1 is the only claim and sets out the method of play of the present invention:

Claim 1. A method of playing a gaming machine in which a bonus round includes an apparent game of skill or knowledge comprising:

- a) a player making a wager to play the gaming machine;
- b) activating the gaming machine to cause a game of chance to occur;
- c) determining an outcome of the game of chance;
- d) if the outcome awards the player with the bonus round, selecting an amount of a bonus payout to be paid to the player

during the bonus round; and

e) allowing the player to participate in the apparent game of skill or knowledge at the end of which the player receives the bonus payout.

6. ISSUES

Whether Claim 1 is unpatentable under 35 U.S.C. §103(a) over Kaufman ('459) in view of Koza et al. ('234).

7. GROUPING OF CLAIMS

Claim 1 stands as the first and only group of claims.

8. ARGUMENTS

Claim 1 is pending in this application.

Claim 1 stands rejected under 35 U.S.C. §103(a) over Kaufman (4624459) in view of Koza et al. (4582324).

Kaufman discloses a slot machine game in which the player can receive multiple payouts, instead of the standard payout shown on a pay table, for achieving a winning outcome. There are apparently two ways in which the player may achieve these multiple payouts:

1 - The gaming machine keeps track of how many winning

outcomes the player has achieved and this accumulated count is shown on a win counter. Prior to each spin of the slot reels, a random number generator selects a number. If that number is equal to the number shown on the win counter, then the player receives a multiple payout if the player achieves a winning outcome on that spin. If a winning outcome is not achieved, then there is no multiple payout, the win counter does not increment, and a new number is randomly selected for the next spin of the reels.

2 -- The gaming machine keeps track of how many winning outcomes the player has achieved and this accumulated count is shown on a win counter. A random number generator selects a number representing the number of wins that are needed to trigger a multiple payout. When the number of wins on the win counter is one less than the randomly selected number, the gaming machine illuminates a signal to the player that the next winning outcome will receive a multiple payout.

In either version of the Kaufman game, the player does not proceed to a bonus round when an outcome of the spin of the reels indicates that the player has won a bonus round. Instead, as taught and disclosed by Kaufman, at some point during the play of the gaming machine, the player is rewarded with a multiple payout of the pay table, instead of the regular single payout of the pay

table. Kaufman teaches or suggests that after an accumulated number of winning outcomes, the player receives a multiplier payout for his next winning outcome.

At page 2, paragraph 2 of the Examiner's Final Rejection, the Examiner argues that "Kaufman teaches that when an outcome awards the player with a bonus payout, the gaming machine determines the amount of the bonus to be played to the player as a bonus payout." The only thing that Kaufman teaches is that a player receives a multiplier payout for the player's next winning outcome after the player has had a number of winning outcomes previously.

Claim 1 specifies that a bonus round is awarded to the player when the outcome of the spin of the reels so indicates. This feature is well known in the art. However, Claim 1 goes on to specify that the amount to be won by the player is selected prior to the player participating in the bonus round. Kaufman does not determine the amount to be won by the player prior to the commencement of the bonus round. The amount won by the player in Kaufman is whatever the payout might be for a winning outcome achieved by the player, which payout could be multiplied in certain situations.

In the present invention as set out in Claim 1, after the amount to be won by the player is selected prior to the player

participating in the bonus round, then the player participates in an apparent game of skill or knowledge as the bonus round. At the end of the player's participation in this apparent game of skill or knowledge, the player is awarded the preselected bonus amount regardless of how well or poorly the player performs in the bonus round.

Kaufman does not have a bonus round of any kind.

The Examiner relies on Koza for the teaching of an apparent game of skill at the end of which the player receives a predetermined payout.

Koza discloses a lottery system that utilizes a plurality of display terminals connected to a central computer. The player is given the illusion that he is playing a skill game; in reality the player is merely participating in a lottery. The player buys an entry in the lottery and, prior to the apparent game of skill occurring, the amount won by the player is determined by the gaming controls.

The player then engages in what appears to be a game of skill - such as the Lady and the Tiger or a game of shooting down spaceships. Because the amount won by the player has been predetermined before the apparent game of skill starts, the player continues to play the displayed game until the player has achieved

an outcome suitable to the predetermined award -- regardless of how good or bad the player is at playing the game.

Koza is not a casino game - Koza is simply a lottery with the amount won by the player, if any, displayed to the player as an apparent game of skill.

Claim 1 requires that the player make a wager and participate in a game of chance. The game of chance results in an outcome. One of the outcomes may award the player a bonus game. The bonus game has a predetermined amount associated therewith which is displayed to the player as an apparent game of skill or knowledge.

Kaufman does not have as any of its outcomes during the play of the casino game that the player can win a bonus game. Koza does not have as any of its outcomes during the play of the lottery that the player can win a bonus game. The combination of Kaufman and Koza does not teach or suggest a casino game in which as any of the outcomes during the play of the casino game is that the player can win a bonus game.

There is no reason to combine Kaufman with Koza, other than hindsight acquired by the Examiner from reading Appellant's disclosure. Without any suggestion in the references that their respective teachings can be combined, there is no reason to so combine them, particularly since neither reference relates in any

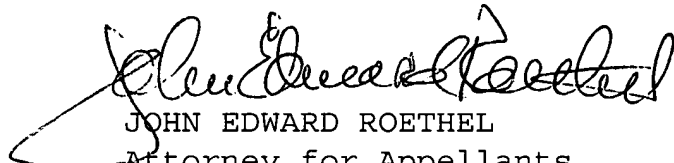
way to bonus games awarded during the play of a game of chance.

9. CONCLUSION

Appellant submits that Claim 1 has been improperly rejected by the Examiner under 35 U.S.C. 103. Appellant respectfully requests that the Board of Appeals reverse the Examiner's rejection of Claim 1 and remand this application to the Examiner for further action consisting of a Notice of Allowance.

An Appendix is attached to this Brief setting out in full the claim on appeal.

Respectfully submitted,



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APPENDIX

Claim 1. A method of playing a gaming machine in which a bonus round includes an apparent game of skill or knowledge comprising:

- a) a player making a wager to play the gaming machine;
- b) activating the gaming machine to cause a game of chance to occur;
- c) determining an outcome of the game of chance;
- d) if the outcome awards the player with the bonus round, selecting an amount of a bonus payout to be paid to the player during the bonus round; and
- e) allowing the player to participate in the apparent game of skill or knowledge at the end of which the player receives the bonus payout.